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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566

7590 12/19/2002
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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,232

Applicant(s)

Samuel Sergio TENEBBAUM

Examiner

Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-21-02
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 58-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 and 58-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Examiner does not find basis in the specification to reasonably convey the claimed features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message to those skilled in the art. Since each of the depending claims are dependent upon non-enabling new subject matter, all are also rejected as being non-enabling because one skilled in the art would not be able to reasonably convey the claimed concept from the specification. Also claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51, and 62 are non-enabling because the specification does not allow one skilled in the art of computer display to define a plurality of characters which are selected and controlled according to information from the user's computer which is not under the user's control and technical features available in the user's computer or wherein an HTML

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page being viewed by a user was received from a content provider's server and the character is introduced therein as result of tags left in the page by the content provider. The user control (or lack thereof) is considered new matter because a user always has control of a computer and one skilled in the art would not be able to enable an uncontrollable computer. However, in order to consider these claims in light of the prior art, examiner will assume that these features are enabling by the specification.

2. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen, communicating a tag to a character controlling server based on client server communications, and selecting a character, greeting, recipient and message which do not have antecedent basis from the specification. Those features fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the lack of an antecedent basis. Since each of the depending claims are dependent upon indefinite subject matter, all are also rejected as being indefinite. Also claims 7, 10, 19, 20, 29, 32, 38, 41, 46, 51, and 62 are indefinite because the specification does not provide antecedent basis to define a plurality of characters which are selected and controlled according to information from the user's computer which is not under the user's control and technical features available in the user's computer or wherein an HTML page being viewed by a user was received

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from a content provider's server and the character is introduced therein as result of tags left in the page by the content provider. The user control (or lack thereof) is indefinite because a user always has control of a computer and the specification does not provide antecedent basis such that one would not be able to define an uncontrollable computer. The tag is indefinite because the specification does not provide antecedent basis such that one would be able to use the tags as claimed. However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Petrecca et al. (US 5,781,894), Reilly et al. (US 5,740,549), Alberts (US 5,937,392), or Schena et al. (US 5,946,646), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by

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Wexler et al. (US 5,960,409), Werkhoven (WO 99/59097), Landsman et al. (WO 99/60504), Krishan et al. (WO 00/30003), or Robinson (WO 00/42593).

5. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The company information posted on one of the assignee web sites states that in 1999 the concept of Shoshkele was created as a technology innovation. The specification recites "advertising is presented on a computer screen in the form of an animated multimedia character that will be referred to as a 'shoshkele'." This recitation is essentially the claimed invention and has been disclosed in public use since 1999. Since the present application was filed in 2001, which is more than one year permitted under 35 USC 102(b), it is statutorily barred from being patented..

Claim Rejections - 35 USC § 103

6. Claims 1-52 and 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of Juno Online Services (hereinafter JUNO) method of computer multimedia advertising. Since at least 1997, JUNO has performed the claimed method comprising:

introducing or displaying into a computer screen a multimedia animated character;

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sending content from a server to a client and providing a tag communicating to a character controlling server (or media source); and

selecting a multimedia animated character, greeting, recipient and sending the character.

Examiner also has personal knowledge of the claimed translational movement, uppermost character display on a multilayer screen, overlaying and transparent charactering, sound display, signal control generation including basis on a user computer, network connectivity and command sending, browser and HTML viewer use, executable code installed in media or file, and payment based on volume or duration access. The claimed introducing or displaying into a computer screen a multimedia animated character occurs when the examiner accessed JUNO's free electronic mail account in which the examiner was presented with a multimedia animated character (known as a pop-up advertisement). The claimed sending content from a server to a client and providing a tag communicating to a character controlling server (or media source) occurs when JUNO would gather demographics associated with examiner user response data to send advertisement presentations based on examiner demographic data and correlating that data to advertisers who would historically target that demographic variable data or tag. The claimed selecting a multimedia animated character, greeting, recipient and sending the character occurs when examiner would compose and send an e-mail alerting others to the pop-up advertisement provided by JUNO advertisers. The claimed invention, recited by the applicants, has been provided by JUNO long before the filing of applicants' invention except for the intrusive, unpredictable, and uncontrollable nature of the character. Examiner notes that it is old and well

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known to those skilled in the art of computer multimedia advertising, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the intrusive, unpredictable, and uncontrollable nature of a character since the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. The introducing or displaying into a computer screen a multimedia animated character would be performed the same regardless of the nature of the character. To one of reasonable skill in the art of computer multimedia advertising, most pop-up advertisements, as claimed by the applicant are intrusive, unpredictable, and uncontrollable. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present a multimedia animated character having any type of nature because such a nature does not functionally related to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention. The motivation to combine applicants claimed invention with the examiner's personal knowledge of JUNO is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

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Response to Arguments

priority

Examiner considers the priority date as claimed by the applicant, however under the recently changed 35 USC 102(e), each of the international applications are considered prior art with respect to the examination of the present application.

requirements for information

Applicant is reminded that although the present examiner conducted a search and IPER of the related international application, "patentability" was not established. An international publication is not considered a patent and the examination requirements are not the same. If all the claims are patentable, as argued by the applicant, then a double patenting rejection would be proper and a terminal disclaimer would be required.

new matter enablement and indefiniteness rejections

Applicant argues that the claimed invention can be realized with existing technology and provides examples of software such as Flash or GIF/WAV. By applicant's own admission, the claimed feature of introducing a multimedia character into a computer screen is old and well known, but that independently ^{the} claimed feature is limited by being a changing image which appears on the screen intrusively in a manner which is unpredictable for the computer user and which is

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completely beyond the user's control. It is the claimed computer screen multimedia character introduction including that limitation that is considered new non-enabling subject matter because one skilled in the art would not be reasonably conveyed of the claimed subject matter based on the specification.

Applicant also argues that the claimed features of selecting a character, greeting, recipient, or message is reasonably conveyed to skilled artisans and enabled from pages 2 and 4 of the specification. However those specification pages are silent to greeting, character, or message selection. It may be implied that a character is selected, but one skilled in the art would not be able to be reasonably conveyed of the claimed greeting, character, or message selection based on the specification.

Applicant further argues that the dependently claimed defining plurality of characters which are selected and controlled not under the user's control would be readily known to those skilled in the art. The specification does not show that the claimed features is readily known and those skilled in the art would not be reasonably conveyed of those features based on the specification. Examiner disagrees with user control of banner advertisement appearance received from web page transmission. Most commonly known firewall applications allow blocking of banner advertisements which, to those skilled in the art, allows user control of web banner transmissions.

All of the claims are considered indefinite because the claimed subject matter lacks antecedent basis from the specification.

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anticipatory rejections

In light of the change in 35 USC 102(e), clearly anticipated rejections under 35 USC 102(a) are now eligible for rejection under the new subsection (e) of that statute.

Applicant argues that Petrecca, Reilly, and Schena do not teach or suggest modifying an image produced on a computer by introducing a multimedia animated character, which is a changing image that appears on the screen intrusively in a manner which is unpredictable for the user and which is completely beyond the user's control. On the face of each of those references, advertisement data servers send data to remote computer users who receive advertisement data information on a monitor being used. The references are a prima facie showing which teaches^{...} an image produced on a computer by introducing a multimedia animated character, which is a changing image that appears on the screen intrusively in a manner which is unpredictable for the user and which is completely beyond the user's control.

given Applicant argues that Wexler or Alberts does not anticipate the claimed invention because that reference^{...} does not suggest use of the type of character argued or that it would be of any benefit. Examiner considers the claimed invention to be clearly anticipated by Wexler or Alberts because the features claimed are taught by either of those reference regardless of the intended use or benefit.

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obviousness rejection

In response that the claimed invention is not an obvious variation of examiner's personal experience, an affidavit is submitted with this Office action. Applicant argues that the non-functional descriptive language "intrusive, unpredictable, and uncontrollable nature of the character" patentably distinguishes the invention. In the field of endeavor to which the applicant seeks to patent the claimed invention, opinions of the nature of the character data transmission do not patentably distinguish the invention from the prior art. Opinion claim language directed to an intended use which does not result in a functional or structural difference with respect to the prior art does not serve as a limitation on the claim (please see *In re Scheiber*, 44 USPQ2d 1429 (Fed.Cir. 1997)). In this case, examiner considers the recited "intrusive, unpredictable, and uncontrollable nature of the character" to not result in a functional or structural difference with respect to the prior art and therefore does not serve to limit the claim over the prior art. Examiner's personal experience is the prior art as supported by the affidavit infra and non-functional descriptive opinion language needs not prior art support for rejection.

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325

Steve Gravini
STEPHEN GRAVINI
PRIMARY EXAMINER

smg
December 17, 2002

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EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION

Claims 1-52 and 58-62 are an obvious variation over examiner's personal knowledge of Juno Online Services (hereinafter JUNO) method of computer multimedia advertising. Since at least 1997, JUNO has performed the claimed method comprising:

introducing or displaying into a computer screen a multimedia animated character;

sending content from a server to a client and providing a tag communicating to a character controlling server (or media source); and

selecting a multimedia animated character, greeting, recipient and sending the character.

Examiner also has personal knowledge of the claimed translational movement, uppermost character display on a multilayer screen, overlaying and transparent charactering, sound display, signal control generation including basis on a user computer, network connectivity and command sending, browser and HTML viewer use, executable code installed in media or file, and payment based on volume or duration access. The claimed introducing or displaying into a computer screen a multimedia animated character occurs when the examiner accessed JUNO's free electronic mail account in which the examiner was presented with a multimedia animated character (known as a pop-up advertisement). The claimed sending content from a server to a client and providing a tag communicating to a character controlling server (or media source) occurs when JUNO would gather demographics associated with examiner user response data to send advertisement presentations based on examiner demographic data and correlating that data to advertisers who would historically target that demographic variable data or tag. The claimed

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selecting a multimedia animated character, greeting, recipient and sending the character occurs when examiner would compose and send an e-mail alerting others to the pop-up advertisement provided by JUNO advertisers. The claimed invention, recited by the applicants, has been provided by JUNO long before the filing of applicants' invention except for the intrusive, unpredictable, and uncontrollable nature of the character. Examiner notes that it is old and well known to those skilled in the art of computer multimedia advertising, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the intrusive, unpredictable, and uncontrollable nature of a character since the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. The introducing or displaying into a computer screen a multimedia animated character would be performed the same regardless of the nature of the character. To one of reasonable skill in the art of computer multimedia advertising, most pop-up advertisements, as claimed by the applicant are intrusive, unpredictable, and uncontrollable. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present a multimedia animated character having any type of nature because such a nature does not functionally related to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention. The motivation to combine applicants claimed invention with the examiner's personal

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knowledge of JUNO is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

Steve Sharin